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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,115	06/10/2002	Anders Eklund	EKLU3001/JEK	3330

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EXAMINER

WINAKUR, ERIC FRANK

ART UNIT PAPER NUMBER

3736

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/069,115	EKLUND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric F Winakur	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: .  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to because of the following informalities: it appears that the term "for" (line 2) should read "or". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 - 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 1 - 5, although the claims are drawn to a method, the claims fail to set forth positively recited method steps; as such, it is unclear what subject matter Applicant intends to cover by the claims. With regard to claim 1, it is unclear if the phrase following the term "whereby" is meant to be considered a limitation of the claim or is merely indicating that a value "can be determined" with the change in frequency information, as is recited in the claim. With regard to claim 6, it appears that the phrase "means of determining" (line 3) should read "means for determining" if Applicant intends to claim the element using a 112, sixth paragraph recitation; it is unclear whether Applicant intends the body of the claim to begin after the term "having" or the phrase "characterized in that". With regard to claims 8 and 10, use of the term "preferably" renders the scope of the claimed subject matter unclear, as it is uncertain whether the phrase following "preferably" is a limitation of the claim.

4. Claim 11 provides for the use of a device, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4/1, 5, 6, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kozin et al. Kozin et al. teach a tonometry measurement method (column 6, lines 23 - 44) that includes determining a change in frequency of an oscillating element. This value is used to determine the intraocular pressure. The relationship between the frequency and intraocular pressure is derived in columns 3 - 5. Figures 4 and 5, and the descriptions thereof, provide details of the device.

7. Claims 6, 8/6, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Keiper. Keiper teaches a vibration tonometer (Figures 2, 3) having a contact portion

69 attached to a resonant portion of the device. A coil subject to a magnetic field is used to measure frequency response of the device when in contact with an eye of a subject, and the measured frequency information is used to determine intraocular pressure. Details of the system are provided in columns 2 - 5; theoretical considerations are provided in columns 6 - 10.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10/6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiper as applied to claim 6 above, and further in view of Sittel. Keiper teaches a vibration tonometer that includes a contact plate 69, but does not particularly teach that the plate has a concave surface. Sittel teaches an alternate vibration tonometer having a contact portion that can be flat or concave and can be designed to take into consideration the physical characteristics of the subject (column 2, lines 61 - 68). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the contact plate of Keiper to have a concave surface, as taught by Sittel, since this is a known alternate form of the contact plate and allows consideration of the subject's physical characteristics to be incorporated into the design.

***Allowable Subject Matter***

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10. The following is a statement of reasons for the indication of allowable subject matter: In addition to the references discussed above, Roth teaches an alternate vibration tonometer. Omata teaches a frequency deviation detecting circuit and associated measuring apparatus that is used for measuring hardness of objects, including biological materials. However, none of the prior art teaches or suggests a method for measuring the pressure in an eye that includes choosing the force with which the contact body is pressed against the eye based upon the pressure of the eye or continuously measuring the frequency characteristic while increasing the contact force until a desired change in frequency characteristic has been reached, and using the contact force at that point to determine the pressure. Further, the prior art does not teach or suggest a device for measuring the internal pressure of an eye that includes a piezo-electric element in the system oscillating in resonance.

11. Claims 2, 3, and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 703/308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0858.

A handwritten signature in black ink, appearing to read 'Eric F. Winakur', with a stylized flourish at the end.

Eric F Winakur  
Primary Examiner  
Art Unit 3736

12 December 2003